Remarks

§ 102 Rejection using U.S. Pat. No. 5,384,173

Claims 1-4, 6, 8-10, 13 and 16-18 were rejected using Patent '173. Applicant traverses this rejection by two means:

(1) incorporation by reference of Applicant's Remarks in the response dated September 21, 2007, in which Applicant demonstrated very clearly that Patent '173 discloses ***an opaque film canister with a roughened inner peripheral wall*** that can not anticipate Applicant's claims;

(2) the following additional arguments which further explain what **an *outer* surface having a matte finish with an etched pattern** and **to add tactile texture and matte finish appearance to the thermoplastic product** mean in Applicant's claims. The amendment to Claim 1 comes from Claim 2.

A review of Applicant's invention is appropriate, using the locators of the published application **20040071936,** with emphasis added.

[0003] Modern consumer products demand eye-catching attention. Producers of consumer products compete for available shelf space in retail businesses. The outer appearance of a product, including its shape, color, texture, and labeling is the first impression for a consumer. Producers undertake considerable efforts to display a desired appearance to attract the consumer to the product. Such outer appearance, over time and with exclusivity, achieves a form of intellectual property for the producer, called trade dress, which offers a visual differentiation for commodity products and another differentiation for unique products.

[0005] Molded products made by the blow-molding techniques take the shape and outer texture according to the mold used.

[0006] What the art needs is a molded product that can be replicated in a shape and outer appearance that combines the visual and tactile sensations of a matte finish.

[0026] The texture of the outer surface of a blow-molded product is dependent on the selection of etching pattern or etching technique within the inner surface of the mold. Etching patterns combine artistry of final appearance with technology of generating the pattern. Such skills are known to those in the art.

[0039] A particularly preferred use of the products of the present invention is in the health and beauty aid (HBA) business where product container appearance is important for trade dress benefits to the producer of the health or beauty aid product.

Abstract

A molded thermoplastic product is disclosed. The product has an outer surface with a matte finish. The matte finish is produced by the combination of an etched mold in which the product is molded to physically affect the outer surface and a colorant compounded in the thermoplastic to chemically affect the outer surface. The colorant provides a diffused translucency. The etching adds tactile texture. The product is made by blow-molding techniques. Containers such as shampoo bottles can benefit from such visual and tactile sensations for the purpose of creating a trade dress for a consumer product.

Outer Surface

Applicant's claimed invention physically affects the outer surface and appearance of the molded thermoplastic product by adding tactile texture via etching the outer surface.

The outer appearance of a modern consumer product is part of trade dress important for certain industries, including health and beauty products. The shampoo bottle on the mass marketer's shelf fights for recognition. The frosting, provided both by chemical and physical affectation, distinguishes that product from other products. Translucency is desired because it helps to know how much of the contents are left before a new product must be purchased.

The phrase: "outer surface" needs analysis. A "surface" is at the interface between a solid and a liquid or a solid and a gas or a liquid and a gas. A "surface" is where the one category of material lies exposed to the other category of material.

The Office considers the roughened face formed on the inner peripheral wall of Akao et al.'s photographic film container to be an "outer surface." Applicant agrees that inner peripheral wall is a surface, but it is definitely not an "outer" surface.

The word "outer" must be given true weight in Applicant's claims. The word "outer" is never identified as being on an inner wall of Applicant's thermoplastic product.

If a surface is at the interface, *regardless of location on a three dimensional object*, then the words "inner" or "outer" have no meaning. **In the manner that the Office construes an "inner wall" to be an "outer surface", there can be no "inner surface" because that nonsensical location would be buried in the bulk of**

the material. The Office's construction eliminates the significance of Applicant's use of "outer" as a modifier to the word "surface."

Applicant uses "surface" in a comparable manner to how Akao et al. use "wall" or "face". But Applicant differs in the location of the matte finish providing tactile texture by locating that physically altered surface on the outside of the thermoplastic product, whereas Akao et al. provide a roughened face on the inside wall to reduce popping sounds, bottom sink marks, and buckling.

Applicant distinguishes an *outer surface* from its antithesis, an *inner surface*, because Applicant wants the matte finish appearance and the tactile texture on the **outer** surface of the molded thermoplastic product where a consumer of a product can see and touch that outer surface.

Diffused Translucency

The entire purpose of a photographic film container is to shield the very light-sensitive film from exposure to light, any amount of light, before planned exposure, frame by frame, during the act of photography. Akao et al. could not tolerate having a diffused translucent photographic film container. The popping sounds and buckling would be small problems compared to the failure of protection from light of the film in the container.

By contrast, Applicant wants diffused translucency as a part of an appearance effect -- a frosted appearance for the molded thermoplastic products. The effects of a frosted appearance -- diffused translucency are compelling in marketing of consumer products.

Novelty of Claims 1-4, 6, 8-10, 13 and 15-18

Applicant is entitled to a patent unless..... During multiple examinations, the Office has not recognized and given true credit to Applicant for his uses in his claims of the phrases "outer surface having a matte finish" and "diffused translucency" and "tactile texture." Akao et al. definitely does not anticipate these claims. A roughenend inner wall of an opaque film container does not anticipate a shampoo bottle with both

(a) an etched outer surface to provide a matte finish and tactile texture and (b) an amount of frost colorant particles to provide diffused translucency but not opacity.

§103 Rejection

Claim 15 was rejected using Patent '173 because of optimization of particle size. As mentioned above, Patent '173 wants an opaque product, whereas Applicant wants a diffusely translucent product. Particle size does play a role in the selection of Applicant's frost colorant. But no one in the art would look to Patent '173 that demands opacity for its photo film container.

Conclusion

Applicant has spent four plus years since the filing of the non-provisional patent application to overcome numerous references. Applicant is entitled to a Notice of Allowance for his claimed invention and will appeal his case if one is not granted.

Respectfully submitted by:

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Date

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